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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,564	06/11/2001	Mimi Chu Dong	10010232-1	3290

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

NAHAR, QAMRUN

ART UNIT PAPER NUMBER

2124

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,564

Applicant(s)

DONG ET AL.

Examiner

Qamrun Nahar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 9/21/04.
2. The objection to claims 10-16 is withdrawn in view of applicant's amendment.
3. Claims 1-2, 4-16, 18 and 22 have been amended.
4. Claims 28-30 have been added.
5. Claims 1-30 are pending.
6. Claims 28-30 stand finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claims 1-30 stand finally rejected under 35 U.S.C. 102(b) as being anticipated by Pleso (U.S. 6,009,480).

Response to Amendment

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claims 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites the limitation "said computer" in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim. Therefore, this limitation is interpreted as "said computer system".

Claims 29-30 are rejected for dependency upon rejected base claim above.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Pleso (U.S. 6,009,480).

Per Claim 1 (Amended):

The Pleso patent discloses:

- **a method for providing application software for a peripheral device to be installed in a computer system** (“The present invention relates generally to a method and system for providing and installing a device driver, and more particularly to a system for integrating a device driver with the device itself.” in column 2, lines 39-53)

- **rendering said application software into a memory module coupled to said peripheral device** (“The peripheral device stores its driver within its own memory” in column 8, lines 39-40)

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- upon coupling said peripheral device to said computer system by a user, querying said peripheral device by an operating system executing on said computer system; and responsive to said querying, uploading said application software into said computer system from said memory module coupled to said peripheral device, said application software including software for effectuating user-customizable settings with respect to operating said peripheral device (“In step 122, the processor 12 scans all devices connected to the system 10 and identifies in step 123 any new devices that have not been configured yet. As mentioned above, in step 120, the processor 12 determines if there are any new devices connected to the system. ... If a new device (e.g. printer 52) is found, the processor 12 in step 126 queries the printer 52 for what resources the printer 52 needs ... After, the assignment, the processor 12 initiates a driver download sequence in step 128. ... The peripheral device stores its driver within its own memory and during the PNP sequence it downloads the driver to the memory (e.g., hard disk) of the host computer 54.” in column 8, lines 12-42 and column 8, lines 54-67 to column 9, lines 1-9; driver includes user-customizable settings with respect to operating said peripheral device).

Per Claim 2 (Amended):

The Pleso patent discloses:

- wherein said rendering said application software into a memory module comprises programming a flash read-only memory (ROM) module with said application software (column 7, lines 49-58 and column 8, lines 38-40).

Per Claim 3:

The Pleso patent discloses:

- wherein said application software comprises at least one of customer usage application software, customer support diagnostic application software, driver software and at least one default setting with respect to said peripheral device (column 7, lines 49-58 and column 8, lines 38-40).

Per Claim 4 (Amended):

The Pleso patent discloses:

- wherein said rendering said application software into a memory module comprises programming a nonvolatile memory (NVM) module with said application software (column 7, lines 49-58 and column 8, lines 38-40).

Per Claim 5 (Amended):

The Pleso patent discloses:

- wherein said rendering said application software into a memory module comprises programming an electrically programmable read-only memory (EPROM) module with said application software (column 7, lines 49-58 and column 8, lines 38-40).

Per Claim 6 (Amended):

The Pleso patent discloses:

- wherein said rendering said application software into a memory module comprises programming an electrically erasable programmable read-only memory (EEPROM) module with said application software (column 7, lines 49-58 and column 8, lines 38-40).

Per Claim 7 (Amended):

The Pleso patent discloses:

- wherein said rendering said application software into a memory module comprises programming a nonvolatile random access memory (NVRAM) module with said application software (column 7, lines 49-58 and column 8, lines 38-40).

Per Claim 8 (Amended):

The Pleso patent discloses:

- wherein said querying said peripheral device comprises making a determination by said operating system whether said application software is compatible with said operating system (column 8, lines 20-29).

Per Claim 9 (Amended):

The Pleso patent discloses:

- wherein said querying said peripheral device comprises making a determination by said operating system whether said application software is compatible with said computer system (column 8, lines 20-29).

Per Claim 10 (Amended):

The Pleso patent discloses:

- wherein said querying said peripheral device by said operating system is performed in association with Microsoft® Windows® operating system (column 14, lines 15-39).

Per Claim 11 (Amended):

The Pleso patent discloses:

- wherein said querying said peripheral device by said operating system is performed in association with a UNIX-based operating system (column 14, lines 15-39).

Per Claim 12 (Amended):

The Pleso patent discloses:

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- wherein said querying said peripheral device by said operating system is performed in association with Linux® operating system (column 14, lines 15-39).

Per Claim 13 (Amended):

The Pleso patent discloses:

- wherein said querying said peripheral device by said operating system is performed in association with Macintosh® MacOS® operating system (column 14, lines 15-39).

Per Claim 14 (Amended):

The Pleso patent discloses:

- wherein said querying said peripheral device by said operating system is performed in association with Solaris® operating system (column 14, lines 15-39).

Per Claim 15 (Amended):

The Pleso patent discloses:

- wherein said querying said peripheral device by said operating system is performed in association with AIX® operating system (column 14, lines 15-39).

Per Claim 16 (Amended):

The Pleso patent discloses:

- wherein said querying said peripheral device by said operating system is performed in association with HP-UX® operating system (column 14, lines 15-39).

Per Claim 17:

The Pleso patent discloses:

- wherein said peripheral device is selected from the group consisting of: a printer, a digital camera and a scanner (column 5, lines 1-15).

Per Claims 18 (Amended) & 20-21:

These are system versions of the claimed method discussed above (claims 1, 3 and 17, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Pleso.

Per Claim 19:

This is a system version of the claimed method discussed above (claims 2, 5, 6 and 7), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Pleso.

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Per Claim 22 (Amended):

This is a computer-readable medium version of the claimed method discussed above (claims 1, 8 and 9), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Pleso.

Per Claim 23:

This is a computer-readable medium version of the claimed method discussed above (claims 2, 5, 6 and 7), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Pleso.

Per Claim 24:

This is a computer-readable medium version of the claimed method discussed above, claim 17, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Pleso.

Per Claim 25:

This is a computer-readable medium version of the claimed method discussed above (claims 10, 11 and 13), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including "Windows® NT® operating system" (column 14, lines 15-39). Thus, accordingly, this claim is also anticipated by Pleso.

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Per Claims 26-27:

These are computer-readable medium versions of the claimed method discussed above, claim 3, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Pleso.

Per Claim 28 (New, as best understood):

This is a peripheral device version of the claimed method discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Pleso.

Per Claim 29 (New, as best understood):

This is a peripheral device version of the claimed method discussed above (claims 2 and 5-7), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Pleso.

Per Claim 30 (New, as best understood):

This is a peripheral device version of the claimed method discussed above, claim 3, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Pleso.

Response to Arguments

12. Applicant's arguments filed on 9/21/04 have been fully considered but they are not persuasive.

In the remarks, the applicant argues that:

a) The following comments were provided with respect to these §102 rejections:

Per Claim 1:

...

Similar comments were also provided with respect to the remaining base claims 18 and 22. Applicant respectfully submits that pending §102 rejections have been overcome or otherwise rendered moot by way of the present amendments as set forth above. The present invention as currently constituted is directed, in one aspect, to providing application software for ...

The Pleso reference does not teach or suggest the present invention as currently claimed at least where the uploadable application software includes software for effectuating user-customization settings with respect to operating a peripheral device.

Accordingly, Applicant respectfully submits that the base claims 1, 18, 22, and 28, as well as the dependent claims that respectively depend therefrom, are allowable over the Pleso reference.

Examiner's response:

a) Examiner strongly disagrees with applicant's assertion that Pleso fails to disclose the claimed limitations recited in claims 1, 18, 22 and 28. Pleso shows each and every limitation in

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claims 1, 18, 22 and 28. Pleso teaches said application software including software for effectuating user-customizable settings with respect to operating said peripheral device (column 8, lines 12-42 and column 8, lines 54-67 to column 9, lines 1-9; driver includes user-customizable settings with respect to operating said peripheral device). In addition, see the rejection above in paragraph 11 for rejection to claims 1, 18, 22 and 28.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Thursdays from 8:30 AM to 6:00 PM. The examiner can also be reached on alternate Fridays.

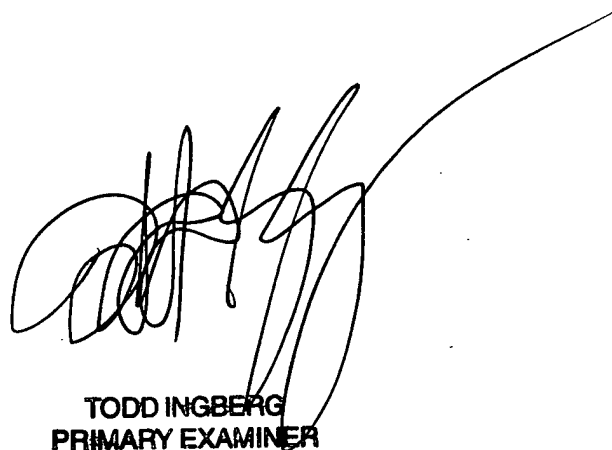
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (571) 272-3719. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QN
December 6, 2004



TODD INGBERG
PRIMARY EXAMINER